

TRANSMITTAL LETTER			Case No. 1391/1275
Serial No. 08/044,240	Filing Date APRIL 7, 1993	Examiner SHERRER, C.	Group Art Unit 1302
Inventor(s) MICHAEL MCHALE ET AL.			
Title of Invention MULTI-PHASE SHEETED CHEWING GUM AND METHOD AND APPARATUS FOR MAKING			

TO THE ASSISTANT COMMISSIONER FOR PATENTS

Transmitted herewith is Brief In Support Of 37 CFR § 1.181 Petition For Entry Of Reply Brief To Examiner's Supplemental Answer; Petition For Entry Of Reply Brief Under 37 CFR § 1.181; Check for \$130.00 and Postcard.

- ☐ Small entity status of this application under 37 CFR § 1.27 has been established by verified statement previously submitted.
- ☐ A verified statement to establish small entity status under 37 CFR §§ 1.9 and 1.27 is enclosed.
- ☐ Petition for a ___ month extension of time.
- ☐ No additional fee is required.
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	Claims Remaining After Amendment		Highest No. Previously Paid For	Present Extra
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Small Entity		or	Other Than Small Entity	
Rate	Add'l Fee		Rate	Add'l Fee
x \$11 =	\$		x \$22 =	\$
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Respectfully submitted,

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Registered Representative

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Signature



PATENT
Case No.: 1391/1275

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Michael MCHALE et al.

Serial No.: 08/044,240

Filed: April 7, 1993

For: MULTI-PHASE SHEETED
CHEWING GUM AND METHOD
AND APPARATUS FOR MAKING

Examiner: Curtis E. Sherrer

Art Unit: 1302

**BRIEF IN SUPPORT OF 37 C.F.R. § 1.181 PETITION FOR ENTRY
OF REPLY BRIEF TO EXAMINER'S SUPPLEMENTAL ANSWER**

Assistant Commissioner for Patents
Washington, DC 20231

Dear Sir:

Request

Applicants respectfully petition the Commissioner for entry of the Supplemental Reply Brief Dated December 16, 1996, in the above-captioned matter into the record before the Board of Patent Appeals and Interferences.

Pertinent Facts

On May 12, 1995, The Examiner rejected all pending claims in the above-captioned application, and made the rejections final. The Examiner argued that all claims are obvious in light of Lorenz (D.E. Patent No. 3,516,852) or Cherukuri et al. (U.S. Patent No. 4,917,806). The merits of the rejection is irrelevant for the purposes of this petition and will not be discussed, except as required in the argument section of this petition.

Applicants filed a Notice of Appeal to the Board of Appeals and Interferences on October 9, 1995. The following Briefs have been exchanged and entered into the record:

Applicants' Appeal Brief, filed February 26, 1996 (Tab 1);

Examiner's Answer, filed July 9, 1996 (Tab 2);

Applicants' Reply, filed September 9, 1996 (Tab 3); and

Examiner's Supplemental Answer, filed November 15, 1996 (Tab 4).

On December 16, 1996, Applicants filed a Supplemental Reply (Tab 5) in response to the Examiner's Supplemental Answer. In a communication dated, January 15, 1997 (Tab 6), the Examiner indicated that he has not entered the Supplemental Reply. The Examiner argues that the Supplemental Reply is not limited to new points of argument or to new grounds of rejection. According to the Examiner, the Supplemental Reply revolves around whether the specification supports certain characteristics of the claimed product. He argues that the issue addressed in the Supplemental Reply was addressed in the entered briefs, and therefore, need not be addressed again in the Supplemental Reply. Accordingly, the Examiner did not enter the Supplemental Reply.

Argument

In the Supplemental Reply (Tab 5), Applicants makes the following points:

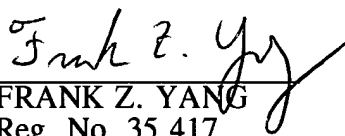
1. The specification at page 5, lines 6-8, and at page 5, lines 17-24, requires the second mass to be smaller than the first mass so that both masses are visible from the top surface. The latter text, in reference to Figure 2, also indicates that the second mass is not visible from the second surface.
2. The various confectioneries taught as the second mass are known to liquefy at the temperature of molten chewing gum. Therefore, a temperature profile is unnecessary.
3. It is well-known that molten chewing gum must be cooled before it can be cut. There is no need to disclose this to the ordinary artisan.

These points track the new points of argument raised in the Examiner's Supplemental Answer (Tab 4):

1. Figure 2 and its associated disclosure in the specification does not inherently teach that the first mass contains the second mass on three sides so that the second mass cannot run or leak through before the product is cooled and hardened. (Tab 4, p. 3, lines 7-11).
2. The disclosure of various confectioneries do not teach the performance characteristics because the applicants failed to teach the temperature profiles of said confectioneries. (Tab 4, p. 3, lines 17-19).
3. The specification does not teach a cooling step to harden the masses, and therefore, if the product is cut before the masses are cooled, the second mass would run off anyway. (Tab 4, p. 3, line 19 to p. 4, line 8).

While the Examiner correctly states that the Supplemental Reply addresses the issue of whether the specification supports certain characteristics of the claimed product, the Examiner erred in determining that the Supplemental Reply does not address new points of argument. The arguments raised by the Examiner are, in fact, new points of argument, which must be addressed or waived by the Applicant. A cursory comparison of the briefs that were previously entered (Tabs 1-4) reveals that the arguments in the Examiner's Supplemental Answer are new points of argument as to why the specification does not support the claimed invention. Therefore, the Examiner clearly erred in refusing to enter the Supplemental Reply. Accordingly, the Petition for Entry of the Supplemental Reply should be granted, and the Supplemental Reply should be entered into the appellate record.

Respectfully submitted,


FRANK Z. YANG
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Date: MARCH 17, 1997

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Signature of person mailing paper or fee)

Docketing No. 1391/1275

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:)	Appeal No. _____
MICHAEL McHALE)	
GEORGE NICHTULA)	
CHRISTINE L. CORRIVEAU)	
WILLIAM WOKAS)	
Serial No. 08/044,240)	Group Art Unit: 1302
Filed: April 7, 1993)	Examiner: C. Sherrer
For: MULTI-PHASE SHEETED)	
CHEWING GUM AND METHOD)	
AND APPARATUS FOR MAKING)	

APPLICANTS' BRIEF ON APPEAL

Honorable Commissioner of
Patents and Trademarks
Washington, D.C. 20231

Dear Sir:

Pursuant to the Notice of Appeal filed on October 9, 1995, Applicants respectfully submit three (3) original copies of this Brief on Appeal, for consideration by the Board of Patent Appeals and Interferences. The items 1) -9) are presented below in

the order set forth in 37 C.F.R. 1.192(c) and include
1) Real Party in Interest, 2) Related Appeals and
Interferences, 3) Status of Claims, 4) Status of
Amendments, 5) Summary of Invention, 6) Statement of
Issues, 7) Grouping of Claims, 8) Argument, and 9)
Appendices. For the sake of convenience, the following
i) Table of Contents and ii) Table of Authorities are
also included.

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1. REAL PARTY IN INTEREST

The real party in interest is the WM. WRIGLEY JR. COMPANY, the current assignee of the patent application.

2. RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences.

3. STATUS OF THE CLAIMS

Claims 1-6, 8, 15-19, 21, 28, 51-54 and 56 are pending in this application. The pending claims are set forth in App. A. All of these claims stand rejected under 35 U.S.C. Section 103 as being obvious over Lorenz (German 3,516,852, App. B), or Cherukuri et al. (U.S. 4,971,806, App. C) in view of Lorenz.

Additionally, claims 7, 9-14, 20, 22-27 and 55 were withdrawn from consideration only due to a species restriction requirement. These claims, which would be allowable if the underlying base claims are allowed, are also included in App. A. Overall, App. A includes claims 1-28 and 51-56 in their present form.

4. STATUS OF AMENDMENTS

All amendments filed to date have been entered, including the Amendment filed by Applicants on July 14, 1995, which was submitted after the final rejection of the claims by the Examiner. In an Advisory Action dated July 24, 1995, the Examiner indicated that the

July 14 Amendment would be entered upon the filing of this appeal.

5. SUMMARY OF INVENTION

The invention is a multi-colored chewing gum product which includes a combination of a first chewing gum and a second confectionery material. As shown in Figs. 1 and 2, for instance, the second confectionery material (15) is embedded in the first chewing gum (13) so that the second confectionery material is visible in a pattern on a first surface of the multi-colored product, but is not visible from a second surface of the product. In all embodiments of the invention, the chewing gum product is in the form of a sheet, for instance a chewing gum stick (Figs. 5 and 6), or a disk-shaped sheet (Fig. 7), or a tape which can be rolled and unrolled (Fig. 1).

Referring to independent claim 1, the second mass is present in a pattern selected from the group consisting of an undulating pattern (Fig. 1), a pattern of stripes across a width of the product (Fig. 4), a diagonal pattern (Fig. 5), a pattern of bits (Figs. 6 and 7), and combinations thereof. Claim 51, the only other independent claim, focuses on the undulating pattern (Fig. 1). Claim 1 (but not claim 51) requires that the second confectionery material is visible only from the top surface of the product, along with the first mass, and that only the first mass is visible

from the bottom surface of the product. The claimed chewing gum products are made possible by a unique embedding process, which differs from prior art processes as explained below.

In the past, it has been known to produce multi-colored chewing gum products by a) coextruding together two or more streams of chewing gum having different colors, or b) forming different chewing gums into ropes, twisting the ropes together, and pressing the ropes into a sheet. In a coextrusion process, different molten chewing gum layers are combined in a single die, and extruded as a sheet. In a rope twisting process, the different ropes are formed separately before being combined. The prior art processes yielded multi-colored products in which a) both components contributed to the structural integrity of the product (and both components were chewing gum), and b) both components were visible from the opposite surfaces of the chewing gum product.

The products of the present invention differ in that only the first chewing gum component needs to have structural integrity because, as shown in Fig. 2, the first chewing gum component (13) generally surrounds the second confectionery material (15) on three sides. Put another way, the second confectionery material is "embedded" into the first chewing gum sheet, instead of being coextruded or twisted together with the first chewing gum sheet.

The embedding process, which forms the products of the invention, is much more versatile than prior art processes. Unlike the coextrusion and rope twisting processes which require both product components to have structural integrity (and compatible viscosities, in the case of coextrusion), the products of the invention are not so limited. So long as the first component is chewing gum, which possesses sufficient integrity, the second "embedded" component can be a wide variety of confectionery materials including taffy, marshmallow, chocolate nougats, gelatin and starch candy as well as chewing gum (specification, p.3, lines 19-22).

Furthermore, the embedding process, unlike coextrusion or rope twisting, can produce products in which the second confectionery material is deposited discontinuously as a pattern of "bits" (Figs. 6 and 7). Additionally, the embedding process can be used to provide continuous patterns of the second confectionery material which are not parallel to the direction of travel of the first chewing gum sheet, such as an undulating pattern visible from only one major surface of the product (Fig. 1) or a diagonal or cross-striped pattern visible from only one major surface of the product (Figs. 4 and 5). Again, because the second confectionery is visible from only one product surface, the second confectionery need not have structural integrity or a compatible viscosity or continuity.

The embedding process used to make the claimed products is illustrated in Figs. 8-20. As shown in Figs. 9 and 11, for instance, the first mass of chewing gum 81 is initially provided as a flat sheet or slab. The second mass of confectionery material can be provided as a plurality of ropes 83, which are guided toward the flat sheet 81 of chewing gum using guide rollers 95 and 101. The guide roller 101 can be oscillated back and forth in order to arrange the ropes in an undulating or other striped pattern on the flat sheet (specification, p. 10, lines 23-32 and p. 11, lines 1-9). Then, the ropes 83 are embedded into the sheet 81 using a pressing roller 106.

Alternatively, the second confectionery material can be arranged on the flat sheet as a pattern of bits as shown in Fig. 20, using the deposition roller 146 having openings 148 for depositing the bits. Then, the bits can be pressed into the flat sheet using a pressing roller such as the roller 106 in Fig. 10.

Applicants realize that the embedding process can be used to make a wide variety of products, some of which may resemble prior art products more closely than others. During prosecution, Applicants limited the claims to recite only specific product embodiments not disclosed or suggested by the prior art, and which are believed to be patentable.

6. STATEMENT OF ISSUES

The main issue presented for review is whether the final rejection of claims 1-6, 8, 15-19, 21, 28, 51-54 and 56 under 35 U.S.C. § 103 as being obvious over Lorenz (German 3,516,852, App. B) or, alternatively, over Cherukuri et al. (U.S. 4,971,806, App. C) in view of Lorenz, should be withdrawn.

Also presented for review is the issue of whether the restriction requirement as to species should be withdrawn. Species claims 7, 9-14, 20, 22-27 and 55 will be affected by this review.

A further issue presented for review is whether the withdrawn species claims should be allowed over the prior art.

7. GROUPING OF CLAIMS

Applicants request that the claims be grouped at least to the following extent:

Group A - Claims 1-6, 15-17, 21 and 28;

Group B - Claims 8 and 18-20; and

Group C - Claims 51-56.

The claims of Groups B and C are believed to be separately patentable from the claims of Group A because Groups B and C require the second confectionery material to be presented in an undulating pattern along a length of the first mass of chewing gum as shown, for example, in Fig. 1. The undulating pattern is a

distinct patentable feature not shown or suggested in the prior art, and can be produced by oscillating the guide roller 101 as shown in Fig. 11 and described at p. 5, lines 23-32 of the specification. Also, the oscillating feature is embodied in Example 1, which identifies the species elected in response to the restriction requirement. The claimed undulating pattern simply cannot be produced by the coextrusion or rope-twisting processes of the prior art, even if the prior art is modified, as discussed further in the arguments below which pertain to these claims. Therefore, the claims of Groups B and C should not stand or fall together with the more generic claims of Group A. (See 37 C.F.R. §§ 1.142(a) and 1.141(a)).

The claims of Group B are believed to be patentably distinct from the claims of Group C in that Group B claims (depending from claim 1) require that the second mass of confectionery material be visible from the top surface of the chewing gum product, along with the first mass of chewing gum, and that only the first mass be visible from the bottom surface of the chewing gum product. The feature of having the second mass visible from only one surface constitutes a separate patentable distinction as to the claimed undulating pattern for the reasons explained in the above Summary of the Invention. Specifically, this feature, which is not suggested in the prior art, allows the second mass of confectionery material a) to

lack structural integrity, b) to have a viscosity different from the first mass, and c) to be deposited discontinuously on the first mass, or in a continuous pattern not parallel to the direction of travel of the first mass. Accordingly, Applicants respectfully submit that the claims of Group B should not stand or fall together with those of Group C.

If the restriction requirement as to species is not sustained, then Applicants request that the species claims previously withdrawn from consideration be grouped as follows:

Group A - Claims 7, 9, 20, 22 and
27, in addition to the
claims listed above;

Group B - Claim 10, in addition to
the claims listed above;

Group C - Claim 55, in addition to
the claims listed above;
and

Group D (new) - Claims 11-14
and 23-26.

As to Group A, claim 7 (nonelected) differs from claims 5 and 6 (elected) only in that the elongated strip of chewing gum is cut into sticks. The Applicants do not understand, and the Examiner has not explained, why the Examiner ever considered claim 7 to be a separate invention from claims 5 and 6, and

withdrew it from consideration. Claim 20 should be also included in Group A for the same reason.

Claim 9 should be included in Group A because it is similar, but not identical to claim 4. Claim 22 should be included in Group A because it recites a method which would yield the product of claim 4. Claim 27 should be included in Group A because the use of a rolling compound on a chewing gum sheet (e.g. the first mass of chewing gum) is conventional.

Claim 10 should be included in Group B because it recites the undulating pattern recited in every other Group B claim. Claim 55 should be included in Group C because it depends from claim 51, and further requires only that the chewing gum product be in the form of a stick.

The claims of Group D (11-14 and 23-26) are believed to be separately patentable from the other three groups. Only the claims of Group D recite that the second confectionery material is present in a pattern of bits which, as shown in Figs. 6 and 7, is a discontinuous pattern. As explained in the above Summary of the Invention, the embedding of a discontinuous pattern of bits of second confectionery material in a first chewing gum sheet is not disclosed or suggested in the prior art (which focuses on coextrusion and rope twisting). Therefore, the claims of Group D should not stand or fall together with any other group of claims.

8. ARGUMENT

In the preceding section, Applicants have argued for a grouping of claims according to the specific patterns of the second confectionery material embedded in the first confectionery material. Specifically, the proposed Group A includes the generic claims and the claims directed to the products of Figs. 2 and 4 (having straight stripes), Group B includes claims directed to the product of Fig. 1 (having an undulating pattern), Group C includes claims directed products similar to Fig. 1 which (unlike Group B) do not require the second confectionery material to be visible only from the top surface, and Group D includes claims directed to the products of Figs. 6 and 7 (in which the second confectionery material is present as a pattern of bits).

The following argument is divided into five sections. First, the restriction requirement as to species is addressed, because the species restriction is not consistent with the proposed groupings of claims. Then, a separate argument is presented for each of the four groups of claims.

i) The Restriction Requirement As To Species
Should Be Withdrawn

In an Office Action dated December 27, 1993, the Examiner imposed various restriction requirements, including a requirement that Applicants elect a

particular species for further prosecution. The Examiner did not state which claims, or groups of claims, were believed to embody patentably distinct species. Instead, the Examiner merely referred to "the process or product associated with the procedure of Example 1" as examples of different species inventions.

The Applicants elected the product associated with Example 1, with traverse, because the species restriction requirement did not comply with M.P.E.P. §814 which states, in pertinent part:

A. Species

As pointed out in Ex parte Ljungstrom, 1905 C.D. 541, 119.0.6.2335, the particular limitations in the claims and the reasons why such limitations are considered to restrict the claims to a particular disclosed species should be mentioned if necessary to make the requirement clear.

Applicants traversed the species restriction on the ground that the Examiner provided no information or reason as to how he was grouping the species claims, or why any particular group of claims was considered patentably distinct from another. The process of Example 1, for instance, can be used to make many of the products shown in the drawings, including the products of Figs. 1, 4 and 5. The Example broadly covers a process which provides the first mass of chewing gum as a slab, and a second mass of chewing gum as a plurality of ropes.

The process of Example 1 uses an oscillator (roller 101, Fig. 9) to deposit the ropes (83 in an

angular pattern on the chewing gum slab (81). Using the oscillator, the ropes can be deposited in an undulating pattern (Fig. 1), or in a diagonal striped pattern (Fig. 5), or even in a cross-striped pattern (Fig. 4) if the angle of cutting is adjusted properly. While Example 1 discloses forming the chewing gum product as a tape (Fig. 1), a person skilled in the art would know that the tape can easily be cut or broken into individual chewing gum sticks (Fig. 5). Moreover, a consumer certainly would break off individual pieces when using the product.

In a subsequent Office Action dated May 10, 1994, the Examiner made the species restriction requirement final, and again refused to set forth a proper basis for the requirement. Additionally, the Examiner withdrew claims from consideration that were within the scope of the elected species (i.e., products which can be produced by the process of Example 1). For instance, the Examiner withdrew from consideration claims 7, 20 and 55, which recited the chewing gum product in the form of a stick. Although Example 1 focuses on producing a chewing gum tape (e.g., Fig. 1), the consumer must certainly separate the tape into sticks, either by hand or by biting, in order to use the product. The Examiner had no proper basis for withdrawing these claims from consideration, or for refusing to explain his grouping of claims..

Also, the Examiner withdrew from consideration claims 9-10 and 22, directed to diagonal patterns and methods of making which can readily be accomplished by the process of Example 1. Again, the Examiner had no proper basis for withdrawing these claims from consideration, or for refusing to explain his grouping of claims.

In summary, a) no proper species restriction requirement has been made or explained, and b) the species election made by Applicants in response to the restriction requirement has not been honored by the Examiner because he failed to consider all claims directed to products which can be made by the process of Example 1. Accordingly, this appeal should be decided without restriction as to species, and all claims set forth in App. A should be considered.

- ii) The Rejection Of Group A Claims 1-6, 15-17, 21 And 28 Under 35 U.S.C. §103 Should Be Withdrawn, And These Claims Should Be Allowed Along With Species-Restricted Claims 7, 9, 20, 22 and 27

Claims 1-6, 15-17, 21 and 28 (the claims of Group A) stand rejected under 35 U.S.C. §103 as being obvious over Lorenz (German 3,516,852, App. B) or, alternatively, over Cherukuri et al. (U.S. 4,971,806, App. C) in view of Lorenz. Applicants respectfully submit that these claims should be allowed, along with the species-restricted claims 7, 9, 20, 22 and 27.

Group A includes independent claim 1, and some of the claims depending from claim 1. The elements of claim 1 (App. A) can be broken down as follows:

A multi-colored, sheeted chewing gum product with a top and bottom surface, comprising:

a first mass of chewing gum formed in a generally flat sheet; and

a second mass of a confectionery product - having a different color than the first mass,

- smaller than the first mass,

- and embedded in the first mass so as to be visible with the first mass from the top surface of the chewing gum product;

the second mass being present in a pattern selected from the group consisting of

- an undulating pattern,

- a pattern of stripes across a width of the product,

- a diagonal pattern,

- a pattern of bits, and

- combinations of the foregoing;

wherein the first mass only is visible from the bottom surface of the chewing gum product.

The German reference (App. B) discloses a coextrusion process for making chewing gum from a plurality of chewing gum streams (Figs. 5, 6). The different chewing gum streams merge and converge within a die (Figs. 5, 6) and exit the die downward as a tubular product having various patterns shown in cross-section (Fig. 7). It should be emphasized that no surface patterns of a chewing gum product are disclosed. Instead, the patterns shown in Fig. 7 only show a cross-sectional cut through the product, which is extruded as a tube having a square or circular cross-section (App. B, p. 5, lines 2-4). However, the surface patterns of the products can be imagined by rotating the coextruded products shown in Fig. 7 by 90 degrees in any direction, thus yielding elongated products having stripes which are parallel to the length of the products.

The German reference fails to disclose or suggest several features of claim 1. First, there is no disclosure of a sheeted chewing gum product, or of a first mass of chewing gum formed into a generally flat sheet. The term "sheet", for instance, would refer to any of the flat, relatively thin products shown in Applicants' Figs. 1-7. Instead, the reference discloses only tubular products having square or circular cross-section, i.e., which are too thick to be characterized as "sheets" (App. B, Fig. 7).

Second, the German reference fails to disclose or suggest a second mass of confectionery material embedded in the first mass in a pattern selected from a) an undulating pattern, as shown in Applicants' Fig. 1, b) a pattern of stripes across a width of the product, as shown in Applicants' Fig. 4, c) a diagonal pattern, as shown in Applicants' Fig. 5, or d) a pattern of bits, as shown in Applicants' Figs. 6 and 7. Instead, the only pattern which can result from the disclosed coextrusion process is a pattern of stripes parallel to the length of the product. Such a pattern is shown, for instance, in Applicants' Fig. 4, but is not within the scope of Applicants' claim 1.

Third, the German reference does not disclose or (6) suggest a product in which a) first and second masses are visible from a top surface of the product, and b) only the first mass is visible from the bottom surface of the product. As explained in the above Summary of the Invention, this feature allows the first chewing gum mass to provide all the necessary structural integrity so that the second confectionery mass can be selected from a wide variety of confectionery materials. As shown in Fig. 7 of the German reference, all of the products which have first and second masses visible from one side, would also have first and second masses visible from the opposite side.

The Cherukuri et al. reference (App. C) also discloses a multi-layered chewing gum composition

formed by coextrusion. The Cherukuri et al. disclosure has the same deficiencies of the German reference with regard to the Applicants' invention, except that Cherukuri et al. does disclose roller pressing of the chewing gum layers, which would form a sheet (col. 2, lines 31-32). Additionally, Cherukuri et al. discloses another process in which ropes of different chewing gums are braided together and rolled into sheets (col. 9, lines 42-45). This latter process would inherently result in products having first and second masses visible from both opposing surfaces of the products. Both of the processes in Cherukuri et al. are limited to combining different chewing gums, and neither would be useful for combining chewing gum with another confectionery material having less independent structural integrity.

References relied upon to support an obviousness rejection must provide an enabling disclosure as to the claimed invention, and must place the claimed invention in the possession of the public. Beckman Instruments, Inc. v. LKB Produkter AB (App. D), 892 F.2d 1547, 1551 (Fed. Cir. 1989). Here, the references relied on by the Examiner do not enable a person skilled in the art to make the products of claim 1, namely, sheeted chewing gum products in which a first chewing gum mass and a second confectionery material are visible from a top surface of the product and only the first chewing gum mass is visible from a bottom surface of the

product. Also, the references do not enable a person skilled in the art to embed a second confectionery material into a first chewing gum mass, in any of the specific patterns recited in claim 1.

In the final Office Action dated May 12, 1995, the Examiner did not dispute that the prior art fails to disclose the specific claimed chewing gum products. Nevertheless, the Examiner stated that the prior art discloses the inlaying of one chewing gum layer within another, in a striped pattern, and alleged that such a pattern is known from BEECHNUT® chewing gum products. The BEECHNUT® products are admitted prior art on page 1, lines 27-29 of Applicants' specification. As explained on page 1, BEECHNUT® is printed with a dye to cause colored stripes and, therefore, does not involve the embedding of a second confectionery material within a first chewing gum mass, as claimed in claim 1. By definition, a dye merely adds color and is not considered to be a second "confectionery" material as defined on page 3, lines 19-22 of the specification.

The Examiner acknowledged that the claimed products "may not be able to be produced by the apparatus or processes disclosed by the prior art" (final Office Action, ¶4). This alone, illustrates that the requirement of an enabling disclosure is not satisfied by the prior art, and the obviousness rejection is improper. Beckman Instruments (App. D), 892 F.2d at 1551.

The Examiner further argued that the claimed products do not require the process disclosed in Applicants' specification, but could be made "by hand." Useful chewing gum products (typically made by forming hot, molten chewing gum into sheets which are rolled and cut) cannot be made "by hand" with any precision or commercial feasibility. Also, the Examiner has cited no prior art, in favor of this assertion. Where the alleged obviousness of an invention different from the prior art is predicated on the level of ordinary skill in the art, specific prior art evidence is needed to show what that level of skill was. In Re Kaplan (App. E), 789 F.2d 1574, 1580 (Fed. Cir. 1986). Because the Examiner provided no prior art showing the manufacture of sheeted chewing gum by hand, this cannot be used to support an obviousness rejection, and the rejection is improper for this additional reason.

Finally, the Examiner argued that the products produced by the prior art, depending on how they are cut into pieces, can be in the designs that are instantly claimed. However, as explained above, the German reference (App. B) discloses only an elongated tubular product and does not disclose a sheeted product. No matter how the tubes are cut into pieces, the resulting form will most likely be tubular and not sheeted. Alternatively, if thin cross-sectional wafers are cut having surfaces corresponding to Fig. 7 of the reference, the products will have first and second

masses passing through the waters and visible from both surfaces.

The Cherukuri et al. reference (App. C) contains no disclosure of any pattern in which a second confectionery mass is embedded in a first chewing gum mass so that both masses are visible from a top surface of the product and only the first chewing gum mass is visible from the bottom surface. Therefore, no matter how the products of Cherukuri et al. are cut, the claimed patterns cannot be made to appear.

Even if the prior art processes could be modified as suggested by the Examiner, to make the claimed products, this would not form the basis for an obviousness rejection unless the prior art suggested the desirability of such a modification. In Re Gordon (App. F), 733 F.2d 900, 902 (Fed. Cir. 1984); In Re Mills (App. G), 916 F.2d 680, 683 (Fed. Cir. 1990). Here, the prior art contains no suggestion of the desirability of embedding a second confectionery mass into a first chewing gum sheet, so that both the second confectionery and first chewing gum are visible from a top surface of the product and only the first chewing gum is visible from the bottom. Furthermore, it is considered that a person of ordinary skill in the art is one who thinks along the lines of conventional wisdom in the art, and is not one who undertakes to innovate in this fashion. Standard Oil Co. v. American Cyanamid Co. (App. H), 774 F.2d 448, 454 (Fed. Cir.

1985); Custom Accessories v. Jeffrey-Allan Industries (App. J), 807 F.2d 955, 962 (Fed. Cir. 1986).

Absent the required teaching or suggestion of the invention as a whole, the Examiner can do no more than piece the invention together by impermissible hindsight, using the claimed invention as a template. Texas Instruments v. U.S. Intern. Trade Comm'n. (App. J), 988 F.2d 1165, 1178 (Fed. Cir. 1993). In order to determine whether an invention is obvious, the invention must be viewed not from the blueprint drawn by the inventors, but from the state of the art existing when the invention was made. Interconnect Planning Corp. v. Feil (App. K), 774 F.2d 1132, 1138 (Fed. Cir. 1985). Applying the proper standards, the obviousness rejection should not be sustained, and the claims of Group A should be allowed.

- iii) The Rejection of Group B Claims 8 and 18-20 Under 35 U.S.C. § 103 Should Be Withdrawn, And These Claims Should Be Allowed Along With Species-Restricted Claim 10

Claims 8 and 18-20 (the claims of Group B) stand rejected under 35 U.S.C. § 1-3 as being obvious over the German reference (App. B) or, alternatively, over Cherukuri et al. (App. C) in view of the German reference. Applicants respectfully submit that these claims should be allowed, along with the species-restricted claim 10.

All of the claims in Group B depend from claim 1, whose patentability has been argued above in connection

with Group A. Therefore, the arguments as to the Group A claims are incorporated herein by reference, and are fully applicable to the Group B claims as well.

Additionally, the claims in Group B embody a further distinction over the prior art in that each claim recites that the second confectionery mass is present in an undulating pattern in the first chewing gum sheet. As shown in Fig. 1, the phrase "undulating pattern" refers to a pattern of stripes which are bent and wavy instead of straight. The undulating pattern is made by oscillating the distribution roller for the second confectionery mass back and forth across the first chewing gum sheet, as explained on page 10, lines 23-30, with reference to Fig. 11.

The claimed undulating pattern is believed to create a further patentable distinction because making the undulating pattern requires the use of an oscillator for distributing one of the confectionery materials relative to the other during deposition. The references cited by the Examiner, namely the German reference (App. B) and the Cherukuri et al. reference (App. C) do not suggest oscillating one confectionery mass relative to another. Furthermore, the claimed undulating pattern simply cannot be produced using the prior art coextrusion processes (in which different streams are combined within a fixed die before extrusion) or the rope-twisting process of Cherukuri et

al. (in which the ropes are joined before twisting and braiding).

Put another way, no amount of creative cutting or pressing, or other modification of the disclosed prior art processes, would yield the claimed undulating pattern. The distance between the invention and the prior art is far greater here than for the typical nonobvious invention where the prior art is not enabling or fails to suggest a modification. Beckman Instruments (App. D), 892 F.2d at 1551; In Re Gordon (App. F), 733 F.2d at 902. Due to the nature of the prior art processes, they cannot be modified to oscillate one stream of confectionery material relative to another, to provide the claimed undulating pattern.

Therefore, the obviousness rejection of the Group B claims should not be sustained, and these claims should be allowed a) for all of the same reasons as the Group A claims, and b) for the additional reason that the undulating pattern recited in the Group B claims is not disclosed or suggested in the prior art.

iv) The Rejection Of Group C Claims 51-56 Under 35 U.S.C. § 103 Should Be Withdrawn, And These Claims Should Be Allowed Along With Species-Restricted Claim 55

Claims 51-56 (the claims of Group C) stand rejected under 35 U.S.C. § 103 as being obvious over the German reference (App. B) or, alternatively, over Cherukuri et al. (App. C) in view of the German reference. Applicants respectively submit that these

claims should be allowed along with species-restricted claim 55.

The claims of Group C include independent claim 51 and claims depending from claim 51. Claim 51 recites, inter alia, a rope of second confectionery material embedded into a slab of first chewing gum having first and second surfaces, with the rope being present in an undulating pattern. Claim 51 further recites that the embedded rope of second confectionery material is visible at the first flat surface in said undulating pattern.

Unlike the claims of Groups A and B, discussed above, the claims of Group C do not preclude the presence of second confectionery material at the second surface of the slab as well. For instance, it would be within the scope of Group C claims to have a rope of second confectionery material embedded into the first chewing gum slab, wherein the rope is thick enough to be visible at both surfaces of the slab.

Independent claim 51 differs from the prior art as follows. The German reference (App. B) discloses bringing different streams of chewing gum together using a multi-channel fixed die, as shown in Figs. 5 and 6. The streams are combined within the die, and exit the die as a single chewing gum tube having a square or circular cross-section as shown in Fig. 7. Because the die is fixed, and all streams combine within the die, it is not possible to oscillate one

confectionery stream in the German reference relative to the others. Therefore, it is not possible to produce the claimed undulating pattern, illustrated in Applicants' Fig. 1, using the prior art process.

The Cherukuri et al. reference (App. C) is even further removed from the invention of claim 51. In addition to failing to suggest the claimed undulating pattern, Cherukuri et al. also fails to suggest the claimed embedding of a rope of second confectionery material into a first chewing gum slab. Instead, this reference appears to focus on a standard coextrusion process in which two or more layers are laminated side-by-side (i.e., are not embedded in one another), and a rope twisting process in which different chewing gum ropes are positioned adjacent to each other and braided (App. C, col. 2, lines 31-32 and col. 9, lines 42-48).

As with the Group B claims, the distance between the Group C claims and the prior art is far greater than for the typical nonobvious invention where the prior art is merely nonenabling, or fails to suggest a modification. Beckman Instruments (App. D), 892 F.2d at 1551; In Re Gordon (App. F), 733 F.2d at 902. Again, due to the nature of the prior art processes, they simply cannot be modified to oscillate one stream of confectionery material relative to another, to provide the claimed undulating pattern.

v) The Species-Restricted Claims 11-14 And 23-26
Of Group D Should Also Be Allowed

The species-restricted claims 11-14 and 23-26 of Group D all depend from claim 1, whose patentability has been argued above in connection with Group A. Therefore, the above arguments as to Group A are incorporated herein by reference, and are fully applicable to the Group D claims as well.

Additionally, the claims of Group D embody a further distinction over the prior art in that each claim recites that the second confectionery mass is present in a pattern of bits in the first chewing gum sheet. As shown in Figs. 6 and 7, the phrase "pattern of bits" refers to a discontinuous pattern in which the second mass is present as a pattern of separate, distinct droplets or domains within the first chewing gum sheet. The pattern of bits is applied using the porous deposition roller 146 shown in Fig. 20, which has a plurality of deposition openings 148.

The claimed pattern of bits is believed to create a further patentable distinction because making this pattern requires a porous deposition roller or another mechanism capable of depositing discrete domains or droplets of the second confectionery material onto the first chewing gum sheet prior to or simultaneous with the embedding. The references cited by the Examiner, namely the German reference (App. B) and the Cherukuri et al. reference (App. C) do not suggest any device for providing a second confectionery material in a

discontinuous pattern of discrete bits, relative to a chewing gum sheet. Furthermore, the claimed pattern of bits simply cannot be produced by the prior art coextrusion processes (in which the different streams are inherently continuous, as in a continuous tape or rope) or by the rope-twisting process of Cherukuri et al. (in which the different ropes are also continuous).

Put another way, no amount of creative cutting or pressing, or other modification of the disclosed prior art processes, would yield a product having the claimed pattern of bits embedded in and visible from only one surface of the product. Again, the distance between the Group D claims and the prior art is far greater than for the typical nonobvious invention where the prior art is not enabling or fails to suggest a modification or motive. Beckman Instruments (App. D), 892 F.2d at 1551; In Re Gordon (App. F), 733 F.2d at 902. Again, the prior art processes simply cannot be used to make the claimed products.

Therefore, the species-restricted claims of Group D should be allowed a) for all of the same reasons as the Group A claims, and b) for the additional reason that the pattern of bits recited in the Group D claims is not disclosed or suggested in the prior art.

9. APPENDICES

In order to aid the Board of Appeals in deciding this case, Applicants are pleased to provide the following Appendices with this brief.

APPENDIX

IDENTIFICATION OF APPENDIX

A	Claims On Appeal
B	German No. DE 3,516,852
C	U.S. Patent 4,971,806
D	<u>Beckman Instruments, Inc. v. LKB Produkter AB</u> , 892 F.2d 1547 (Fed. Cir. 1989)
E	<u>In Re Kaplan</u> , 789 F.2d 1574 (Fed. Cir. 1986)
F	<u>In Re Gordon</u> , 733 F.2d 900 (Fed. Cir. 1984)
G	<u>In Re Mills</u> , 916 F.2d 680 (Fed. Cir. 1990)
H	<u>Standard Oil Co. v. American Cyanamid Co.</u> , 774 F.2d 448 (Fed. Cir. 1985)
I	<u>Custom Accessories v. Jeffrey- Allan Industries</u> , 807 F.2d 955 (Fed. Cir. 1986)

APPENDIX

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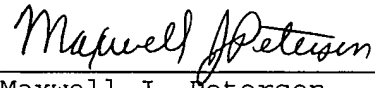
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IDENTIFICATION OF APPENDIX

Texas Instruments v. U.S. Intern.
Trade Comm'n., 988 F.2d 1165 (Fed.
Cir. 1993)

Interconnect Planning Corp. v.
Feil, 774 F.2d 1132 (Fed. Cir.
1985)

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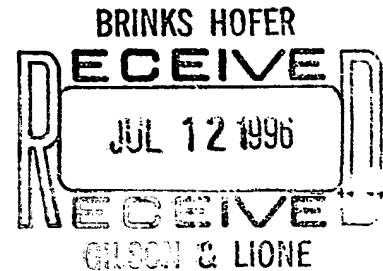
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Please find below a communication from the EXAMINER in charge of this application.

Commissioner of Patents





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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 19

Serial Number: 08/044,240
Filing Date: 04/07/93
Appellant(s): MICHAEL McHALE, GEORGE NICHTULA, CHRISTINE L.
CORRIVEAU, WILLIAM J. WOKAS

Maxwell J. Petersen
For Appellant

JUL 09 1996

EXAMINER'S ANSWER

This is in response to appellant's brief on appeal
filed 02/26/96.

(1) Real Party in Interest

A statement identifying the real party in interest is
contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and
interferences which will directly affect or be directly affected
by or have a bearing on the decision in the pending appeal is
contained in the brief.

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(3) Status of claims.

The statement of the status of claims contained in the brief is correct. It is noted that applicants' broadly sweeping statement that the non-elected claims "would be allowable if the base claims are allowed" is considered inaccurate. According MPEP § 806.04(h):

Where, however, an applicant optionally files another national application with claims to a different species or for a species disclosed but not claimed in a parent case as filed and first acted upon by the examiner, there should be a close investigation to determine the presence or absence of patentable difference. See M.P.E.P. §§ 804.01 and 804.02.

(4) Status of Amendments After Final.

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Invention

The summary of invention contained in the brief is deficient because in the second paragraph, on page 3, applicants assert that "only the first chewing gum needs to have structural integrity", and, even in view of the language that follows this passage, the said passage is considered to present an aspect that is not disclosed in the specification.

Further, applicants' summary of the invention discusses 1) the prior processes for making chewing gum and 2) the process of producing the claimed products and, as stated in

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M.P.E.P. § 1206(5), the summary should consist of a "concise explanation of the invention defined in the claims" (emphasis added). Therefore, the discussion of the process, which starts at the first full sentence of page 3, and continues to the end of the summary, is considered not to be a summary of the invention.

(6) Issues.

Appellant's brief presents arguments relating to whether the restriction requirement as to species should be withdrawn. This issue relates to petitionable subject matter under 37 CFR 1.181 and not to appealable subject matter. See M.P.E.P. §§ 1002 and 1201.

Because the previous issue relates to petitionable subject matter the issue of whether the withdrawn species should be allowed over the prior art is also considered to be an improper issue for appeal. It is noted at this time that any and all language directed to the discussion of these issues will not be dealt with.

Appellants' remaining issue, i.e., the 35 USC § 103 rejection, in the brief is correct.

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(7) Grouping of Claims

Appellants' brief includes a statement that claims 1-6, 8, 15-19, 21, 28, 51-54 and 56 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

The appellant's statement in the brief that certain claims do not stand or fall together is not agreed with because Appellants' Group A contains the limitation of the gums' pattern be in an undulating design and this is the species which Appellants elected for the Examiner to prosecute. The fact that Groups B and C have this same limitation is therefore inconsequential.

Appellants' Group B is not considered to be distinct from Group C because in view of the specification the claimed products are the same. Specifically, according to the claimed process by imbedding the second mass into the first mass it is inherent that the second mass will not be visible from the bottom of the first mass in light of the fact that the specification fails to disclose how the second mass could be smashed down through the first mass so as to be visible from the bottom.

(8) Claims Appealed

A substantially correct copy of appealed claims 1-6, 8, 15-19, 21, 28, 51-54 and 56 appears on pages 1 to 6 of the Appendix to the appellant's brief. The minor errors are as

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follows: In Claim 4, the phrase --width of-- should be inserted before the phrase "first mass".

(9) Prior Art of Record

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

4,971,806	CHERUKURI ET AL.	11-1990
DE 35 16 853 A1	LORENZ	11-1985

(10) Grounds of Rejection

Claims 1 to 6, 8, 15 to 19, 21, 28, 51 to 54 and 56 are rejected under 35 U.S.C. § 103 as being unpatentable over Lorenz (D.E. Pat. No. 3,516,852) or Cherukuri et al. (U.S. Pat. No. 4,971,806) in view of Lorenz.

Lorenz discloses the use of a multichannel chewing gum extruder to produce differently designed chewing gums with cross sections as seen in Figure 7. The patent "is based on the problem of offering a very practical extruder with a high output to manufacture multicolor compound products without theoretically limiting the number of colors or shapes." (Pages 3 to 4 of translation). Lorenz states that "the multichannel extruder [is] described for a three-color extruder" and that the "technology used is suitable for more colors" and that the "only limitation is a practical one" (page 5, lines 5 to 8).

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When viewing the cross sections of the chewing gums in Figure 7 it is seen that the six cross sections on the left hand side of the Figure are square or what could be broadly considered "sheeted" with a top and bottom surface. As stated above the gums are multicolored. When viewing Figure 7, the fifth and sixth square gums are considered to most closely fit applicants' instant invention. A first mass (considered to be the majority of the gum's cross section) is formed in a "generally flat sheet" and has a smaller second mass of a different color imbedded into the first mass.

With respect to the first mass, as compared to the second mass, it is only visible from the bottom. Further, a third mass, which is distinct and separate from the first and second masses (and possibly even a different color), is visible from the bottom. Therefore, it is considered that, Appellants' claim limitation, i.e., that "the first mass only is visible from the bottom surface of the chewing gum product", is met by the disclosure of Lorenz because the claims do not exclude other masses, i.e. a third mass from being visible from the bottom. Specifically, the claim language is interpreted as requiring only first mass is visible from the bottom rather than both the first and second masses.

Lorenz is not relied on to teach a process of how to make the claimed product or the exact design of the claimed product

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but rather, to teach that chewing gums are commonly produced in unlimited designs using various shapes and colors. It would have been obvious to one of ordinary skill in the art to modify the designs disclosed by Lorenz to produce the smaller masses in the shape of bits because various designs are shown to be equivalent in Lorenz.

Appellants argue that apparatus and method of Lorenz (which is not relied upon in rejecting the claims) are not capable of producing the claimed product. In answering this argument it is asserted that by merely intermittently injecting separate and distinct masses into the extruder, the some of the claimed chewing gum designs can be manufactured. Further, while Lorenz relies on an extruder, it is considered that one at home with the use of two different confections could produce all of the claimed designs (most of which are embodied in non-elected claims) by merely using a rolling pin and a knife.

It would have been obvious to one of ordinary skill in the art to modify the design of a second mass imbedded in a first mass of a chewing gum to be in an undulating pattern (the elected species) since those in the art are fully aware that consumers take pleasure in consuming confections of various designs.

Lorenz does not teach the use of multiple flavors but merely multiple colors. For the same reason that consumers desire multi colored confections they would also desire multi-flavored

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confections and it would have been obvious to one of ordinary skill in the art to modify the extruded gums of Lorenz to include multiple flavors since Lorenz teaches the well known concept of producing gums having multiple designs using multiple colors and to add a different flavorant to each different color is a choice that is routinely made by one in the confectionery art to optimize the desirability of the final confection.

While Lorenz does not teach the several process steps as claimed (Claims 15 et al.) these limitations are not considered because the product is obvious no matter how it is produced and merely because a process for producing an article might be patentable does not endow the article with patentability without a showing of some unexpected results. While motivation to make the article by non-elected claimed process is not shown, the motivation to make the article by another method is shown. The Examiner relies on *In re Thorpe*, 227 U.S.P.Q. 964 (Fed. Cir. 1985), wherein the court held that

Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art the claim is unpatentable even though the prior product was made by a different process.

Alternatively, Cherukuri et al. disclose a multi-layered chewing gum composition composed of "at least two combined

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compositions having different base constituents" (col. 2, lines 7 to 12.) The gum layers are "laminated together by conventional methods, e.g., co-extrusion, roller pressing, etc." (col. 2, lines 32 to 33.) The inventors contemplate using a clear wrapping for their product so that "the consumer is able to observe the multi-color designs and color variations in the compositions of this invention. The chewing gum composition contains flavors in the different layers which "may be the same or different and the amounts may be the same or different" (col. 3, lines 57 to 60.)

Table III, in col. 11 of the specification, shows the combination of colors which are contemplated by the invention. From the teaching, cited above, since a multi-color design is viewable by the consumer then it is apparent that one of the layers is larger than the other layer thereby allowing the viewing of at least two colors.

Even if Cherukuri et al. does not explicitly show the various forms which the final chewing gum can have then it is considered that it would have been obvious to one of ordinary skill in the art to vary the designs of the chewing gum products of Cherukuri et al. as done by Lorenz to make the product more attractive to the consumer because it is known in the chewing gum art to mix two gums together in attractive patterns.

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(11) Response to argument

Appellants argue that the process of producing the claimed article is not anticipated or obviated by the prior art. As discussed above, this argument is not persuasive because the article would have been obvious regardless of how it was produced. As held in *Eskimo Pie Corp. v. John Levous and Purity Ice Cream Co.*, 3 U.S.P.Q. 23 (1929), "[t]here is no invention in merely changing the shape or form of an article without changing its function except in a design patent."

It is noted again that Appellants seem to assert that the design of the instant product provides for "the necessary structural integrity." (Page 16). While this evidence is of the proper nature to overcome the above rejections, it is considered that its presentation is improper because the evidence has no antecedent basis in the application. Further, it is considered that this evidence is not inherently disclosed in the specification because no reference is made to what type of structural integrity a mass of chewing gum requires. Lastly, and most importantly, the claims contain no language directed to the gum's "structural integrity" and therefore the Examiner is unpersuaded by this evidence.

Appellants argue that the references do not enable one in the confection art to make the claimed products. As previously stated, the reference was cited merely to disclose the

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obviousness of the product and the motivation. It is considered that the skill required to produce the instant products is well within the skill of one of ordinary skill. As previously mentioned, the apparatus of Lorenz or one's two hands, a rolling pin and a knife are all that are required to produce the instant products. The act of imbedding is not a highly technical feat as Appellants assert.

On this last point, Appellants desire the Examiner to produce evidence of one of ordinary skill in the art. Based on both of the cited patents above, it is clear that the skill of those in the confection art is high indeed. Lorenz relies on a highly sophisticated extruder while Cherukuri et al. rely on braiding and rolling machines or a co-extruder.

Appellants refer to a statement by the Examiner where he stated that the disclosed chewing gums could be modified simply by judiciously cutting the gums with a knife. Examiner stands by this statement and further explains that by taking the fifth generally sheeted confection and cutting it horizontally just below the top imbedded mass that you would indeed produce an article that contained a second mass embedded in a first mass whereby no other mass could be seen from the bottom. Further, the extrusion process of Lorenz could be modified by merely extruding only one second mass so that the fifth gum would only have second mass on its top surface.

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Appellants also discuss the applicability of the well known BEECHNUT® striped chewing gum as prior art. The Examiner mentioned this piece of admitted prior art only to provide another well known example of an obvious design choice.

It seems that Appellants desire legal support for the assertion that if the prior art does not disclose the specifically claimed design then a utility patent should be forthcoming. It is considered that this is inconsistent with established patent law. For support, the Examiner relies on *In re Dailey*, 357 F.2d 669, 149 U.S.P.Q. 47 (CCPA 1966), where the court held that the configuration of the claimed disposable plastic nursing container was a matter of choice which a person of ordinary skill in the art would have found obvious absent persuasive evidence that the particular configuration of the claimed container was significant.

It is finally noted, that with respect to the prosecution of a design patent that differences between a claimed design and the prior art may comprise those of surface indicia or of shape or form of the article of manufacture embodying the design and that whether any particular ornamentation is embossed on or impressed in the surface to which it is applied is considered a matter of choice well within the skill of the ordinary designer. See 109 U.S.P.Q. 57 (CCPA 1956). It is therefore considered that, in the

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absence of some unexpected result, that Appellants are merely modifying preexisting designs, which would have been obvious.

Finally, the relevant statute for design patents, i.e., 35 U.S.C. 171 Patents for designs, states that:

Whoever invents any new original and ornamental design for an article of manufacture may obtain a patent therefor, subject to the conditions and requirements of this title.

In M.P.E.P. 1502.01, it is stated that

a "utility patent" protects the way an article is used and works (35 U.S.C. 101) while a "design patent" protects the way an article looks (35 U.S.C. 171). The ornamental appearance of an article includes its shape/configuration or surface ornamentation upon the article, or both. Both design and utility patents may be obtained on an article if invention resides both in its utility and ornamental appearance."

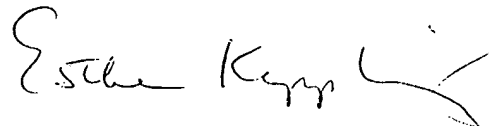
The "utility" of Appellants' article is that it is a confection.

The "invention" of applicants' article is in its design.

Appellants have provided no evidence to the contrary.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



ESTHER KEPPLINGER
SUPERVISORY PATENT EXAMINER
GROUP 1300

Curtis E. Sherrer
July 3, 1996

Maxwell J. Petersen
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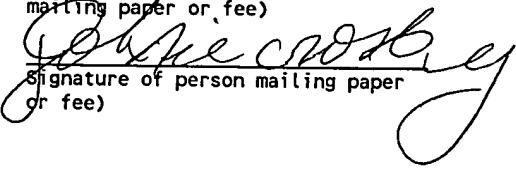
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JOHNIE CROSBY

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(Signature of person mailing paper or fee)

Docketing No. 1391/1275

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:)	Appeal No. _____
)	
MICHAEL McHALE)	
GEORGE NICHTULA)	
CHRISTINE L. CORRIVEAU)	
WILLIAM WOKAS)	
)	
Serial No. 08/044,240)	Group Art Unit: 1302
)	
Filed: April 7, 1993)	Examiner: C. Sherrer
)	
For: MULTI-PHASE SHEETED)	
CHEWING GUM AND METHOD)	
AND APPARATUS FOR MAKING)	

APPLICANTS' REPLY BRIEF ON APPEAL

Assistant Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

Pursuant to 37 C.F.R. § 1.93(b), Applicants submit the following reply to the Examiner's Answer dated July 9, 1996. This reply addresses only new points raised by the Examiner, i.e. points not already addressed in Applicants' opening brief.

I. THE EXAMINER CITES THE WRONG AUTHORITY
FOR TREATMENT OF NON-ELECTED SPECIES CLAIMS

The Examiner incorrectly cites MPEP 806.04(h) as support for his position on the treatment of non-elected species claims (Answer, p-2, ¶3). That section applies only to treatment of species claims in separate divisional applications. When the non-elected species claims are in the same application as the elected claims, the non-elected claims are allowable with the underlying base claims, provided they are in proper form. MPEP § 809.02(c) provides:

(2) When a generic claims is subsequently found to be allowable, and not more than a reasonable number of additional species are claimed, treatment should be as follows:

(i) When all claims to each of the additional species are embraced by an allowable generic claim as provided by 37 C.F.R. § 1.141, applicant should be advised of the allowable generic claims and that claims drawn to the non-elected species are no longer withdrawn since they are fully embraced by the allowed generic claim.

(ii) When the case is otherwise ready for issue and there is an allowed generic claim, and applicant has not been previously notified of the allowance of a generic claim, applicant should be advised of the allowance of a generic claim and given a time limit of 1 month to conform all of the claims of the nonelected species to fully embrace an allowed generic claim.

All of Applicants' species claims (whether elected or non-elected) depend from generic claims that are being considered on their merits. Therefore, if the independent claims are allowed, then all of the dependent claims should be allowed.

Whapeton Canvas Co., Inc. v. Frontier, Inc. (Exh. L), 870 F.2d 1546, 1553 (Fed. Cir. 1989) ("A dependent claims includes all of the limitations of the claim from which it depends...")

II. APPLICANTS' SUMMARY OF THE INVENTION IS CORRECT

The Examiner wrongly states that Applicants' summary of the invention is improper because it discusses the prior art. 37 C.F.R. § 1.192 requires the opening brief to contain "a concise explanation of the invention defined in the claims...". There would be no invention if the claims were not distinguishable from prior art. Therefore, a brief discussion of prior art, and how the claimed invention differs, is entirely within the rule.

Furthermore, the rule does not limit Applicants' explanation of the invention to the exact words in the specification. Under 35 U.S.C. § 112, claims must be supported in the specification; explanations need not be. In any event, the assertion that only the first chewing gum needs structural integrity (which the Examiner finds unsupported) is suggested by the specification.

The specification expressly states that each segment of product includes some of the first chewing gum mass with some of the second confectionery mass embedded therein and visible with the first mass from the top surface (p. 2 lines 19-21). Preferably, the second confectionery mass is not visible from the bottom surface of the product (p. 5 lines 23-24). Persons skilled in the art would understand from this, that the second mass is supported in the first mass, so that only the first mass needs structural integrity in the preferred embodiment.

III. APPLICANTS' GROUPING OF CLAIMS IN PROPER

The Examiner incorrectly argues that Groups A and B are not distinct because both groups contain the limitation of the undulating pattern. The difference is that the claims of Group B require the undulating pattern, while the claims of Group A recite it as an alternative.

The Examiner incorrectly argues that Groups B and C are not distinct based on an unsupported hypothesis that the claimed products are inherently the same. There is no need for the

specification to describe that which is known to persons skilled in the art, namely:

how the second mass could be smashed down through
the first mass so as to be visible from the bottom
(Answer, p. 4)

Persons skilled in the art know that chewing gum products are often very thin, and could be easily penetrated during embedding of secondary confections as listed on page 3 lines 19-23, absent preventative measures. Therefore, the described process does not inherently yield products with the second confection visible at only one surface.

IV. THE EXAMINER'S PRIOR ART ARGUMENTS ARE GROUNDING IN HINDSIGHT AND IMPROPER CLAIM CONSTRUCTION

The Examiner argues that the German reference to Lorenz (Opening Brief, Exh. B) suggests the claimed invention if the Applicants' claims are broadly construed. However, the claim constructions assumed by the Examiner are impermissibly broad, and not consistent with Applicants' specification.

First, the Examiner argues that products in Lorenz having a square cross-section are "sheeted" as required by Applicants' claims (Answer, p. 6). Claim limitations must be construed according to Applicants' specification. Applicants' specification discloses only conventionally sheeted chewing gum products, which are wide and thin, and does not disclose square products. Accordingly, the term "sheeted" should not be given the unconventional meaning suggested by the Examiner.

Second, the Examiner argues that the claim limitation that "the first mass only is visible from the bottom surface of the chewing gum product" should be construed to permit a third mass to be visible from the bottom, along with the first mass (Answer, p. 6). Again, this construction is contrary to the express claim language (i.e., contrary to the word "only"), and is contrary to Applicants' specification (See Figs. 2, 8-9, and 11-12).

Third, the Examiner argues that Lorenz teaches equivalent products and, therefore, the claimed products would have been obvious. However, the products in Lorenz are not structurally or functionally equivalent to those claimed because a) Lorenz does not disclose sheeted products, (b) Lorenz does not disclose products in which a first mass only is visible from a bottom surface, and c) Lorenz does not disclose products wherein the second mass has an undulating pattern, a pattern of cross-stripes, a diagonal pattern, or a pattern of bits as recited in Applicants' independent claims.

Fourth, the Examiner argues that the claimed products could have been made by modifying the process of Lorenz, or at home using a rolling pin and knife. In short, the Examiner relies on Applicants' disclosure as the teaching, and applies impermissible hindsight to speculate on how the invention could have been made given the benefit of Applicants' specification. As stated by the Federal Circuit in In Re Fine (Exh. M), 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir. 1988):

To reach a proper conclusion under § 103, the decisionmaker must step backward in time and into the shoes worn by a person having ordinary skill in the art when the invention was unknown and just before it was made. In light of all the evidence, the decisionmaker must then determine whether the claimed invention as a whole would have been obvious at that time to that person (emphasis added).

There is no suggestion in Lorenz or any of the prior art to make the modifications suggested by the Examiner. The Examiner cannot substitute personal opinions and hindsight to fill the gaps that are missing in the prior art.

Fifth, the Examiner argues that the claimed product is obvious no matter how it is produced, notwithstanding that the process disclosed in Lorenz does not produce the claimed product (Answer, p. 8). No product is obvious without a teaching or suggestion in the prior art. Lorenz not only fails to teach the

claimed product, but fails to provide means or motivation for making the claimed product.

Sixth, the Examiner argues that Cherukuri et al teaches multi-layered, multi-colored designs (Answer, pp. 8-9). Again, Cherukuri et al. (Opening Brief, Exh. C) fails to suggest a product in which a second mass is embedded in a first mass so that only the first mass is visible from the bottom surface of the product.

Finally, the Examiner argues that Applicants are seeking to patent a design which has no utility apart from the new design (Answer, pp. 10-13). This argument was raised only on appeal, and there has been no rejection under 35 U.S.C. § 101. The utility of the invention as claimed lies in the fact that the second mass is embedded into the first mass as shown in Fig. 2, so that only the first mass is present at the bottom surface of the product. It is apparent from Fig. 2 that the first mass contains the second mass on three sides, so that the second mass cannot run, or leak through the product, before the product is cooled and the masses harden. This permits great versatility in the selection of the second mass.

As explained on page 3 of the specification, the second mass may be chewing gum, taffy, marshmallow, chocolate, nougat, gelatin-based candy, starch-based candy, and the like. Because the second mass is embedded as claimed, the second mass does not need to (but may) have a self-supporting structural integrity during manufacture and processing of the product. The first mass (which is required to be chewing gum) supports and contains the second mass because chewing gum (by its nature) possesses the required integrity.

In summary, Applicants have claimed a product structure that is not disclosed or suggested in the prior art, and the claimed structure has utility. An obviousness rejection must be based on an objective evaluation of the prior art, and neither the Examiner's personal opinions nor the Applicants'

specification can be used to fill gaps in the prior art. The prior art does not suggest the claimed invention.

Respectfully submitted,

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Patent and Trademark Office

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/044,240

1391/1275

1391/1115

JEFFREY M. DUNCAN
WILLIAM BRINKS OLDS HOFER GILSON & LIONE
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EXAMINER

ART UNIT

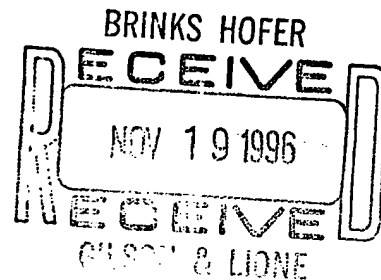
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11/15/96

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Washington, D.C. 20231

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 23

Serial Number: 08/044,240

Filing Date: 04/07/93

Appellant(s): MICHAEL McHALE, GEORGE NICHTULA, CHRISTINE L.
CORRIVEAU, WILLIAM J. WOKAS

Maxwell J. Petersen
For Appellant

Mailed
11/15/96
Group 1300

SUPPLEMENTAL EXAMINER'S ANSWER

This is in response to appellants' reply brief filed 09/09/96, which has been entered. The application has been forwarded to the Board of Patent Appeals and Interferences for decision on the appeal.

Appellants make several points to which the Examiner maintains his position as set forth in the Examiner's Answer. These points are contained in sections I, II and III of the reply brief.

With respect to section IV, the Examiner would point out that Appellants have again relied on unsupported assertions to

Serial Number: 08/044,240

Art Unit: 1302

argue their case. Specifically, Appellants state that "[i]t is apparent from Fig. 2 that the first mass contains the second mass on three sides so that the second mass cannot run or leak through the product, before the product is cooled and the masses harden. This permits great versatility in the selection of the second mass." (See page 6, second full paragraph of Reply Brief).

First, it is considered that, upon viewing Fig. 2 and its associated specfical disclosure (beginning on page 5, line 17), the figure does not inherently or otherwise teach the above assertion. Secondly, no basis for this assertion was found in the remaining portions of the specification. As an aside, its placement into the specification would be considered new matter.

Appellants seem to assert that the specification inherently teaches the above quoted performance characteristics of the instant product because the specification teaches the use of several compositions of which the second mass can be comprised. What Appellants fail to teach is what the temperature profiles of the second masses are as the chewing gum proceeds down the assembly line. Further, the specification does not teach a cooling step to harden the masses or for any reason. Further

Serial Number: 08/044,240

Art Unit: 1302

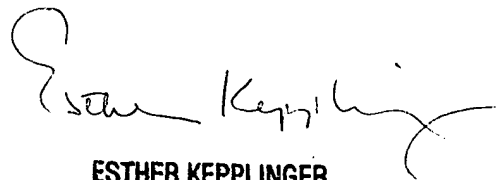
yet, several of the chewing gum product designs are cut (see Figs. 1, 4 and 5) so as to expose the second mass to view on the side of the gum and it is considered that if the instant gum is incapable of being produced satisfactorily without the asserted cooling step (before cutting the gum) due to the fact that the second mass will 'run off' of the first mass then it might be asserted that the specification is defective with respect to the newly asserted point.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Curtis E. Sherrer
November 13, 1996

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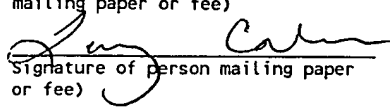

ESTHER KEPPLINGER
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GROUP 1300

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Date of Deposit December 16, 1996

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LARRY COLLINS
(Typed or printed name of person mailing paper or fee)


(Signature of person mailing paper or fee)

Docketing No. 1391/1275

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:)	Appeal No. _____
)	
MICHAEL McHALE)	
GEORGE NICHTULA)	
CHRISTINE L. CORRIVEAU)	
WILLIAM WOKAS)	
)	
Serial No. 08/044,240)	Group Art Unit: 1302
)	
Filed: April 7, 1993)	Examiner: C. Sherrer
)	
For: MULTI-PHASE SHEETED)	
CHEWING GUM AND METHOD)	
AND APPARATUS FOR MAKING)	

APPLICANTS' REPLY TO THE
SUPPLEMENTAL EXAMINER'S ANSWER

Assistant Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

Applicants respectfully submit the following reply to the SUPPLEMENTAL EXAMINER'S ANSWER dated November 15, 1996. This reply addresses only the supplemental points raised by the Examiner.

First, the Examiner argues that there is no basis in the specification for Applicants' assertion that the first mass contains the second mass on three sides so that the second mass cannot run or leak through the product. In response, the specification states:

The second mass is smaller than the first mass and is embedded in the first mass so as to be visible with

the first mass from the top surface
of the chewing gum (p. 2 lines 6-8)

* * * * *

Referring also to the cross-section
in Figure 2, it can be seen that
this novel chewing gum product
includes a first mass of chewing
gum 13 and a second mass of a
confectionery product 15 which has
a different color from the first
mass and which is embedded in and
visible from the top surface of the
first mass. . . Preferably, the
second mass is not visible from the
bottom surface of the first mass
(p. 5 lines 17-24).

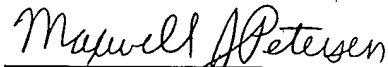
Figure 2 plainly shows a second mass 15
surrounded on three sides (left side, bottom side, and
right side) by a first mass 13. The drawing, taken in
conjunction with the above-quoted passages, plainly
supports Applicants' position. The specification also
teaches the use of chocolate, taffy, marshmallow, etc.
as the second mass. These confections are known to
liquify and run at temperatures typical of molten
chewing gum. Further explanation is not necessary to
ensure an understanding by persons skilled in the art.

The Examiner argues that the specification
does not give temperature profiles of the second masses
as the chewing gum is made. Again, it is well known
that chewing gum in a molten state is hot enough to
melt chocolate, etc. Also, a molten chewing gum
temperature of about 140°F is disclosed at p. 8, line
25, and is hot enough to melt chocolate. Further
discussion of temperature is not necessary.

Finally, the Examiner argues that there is no disclosure of a cooling step to harden the product for cutting. It is well known to persons skilled in the art that molten chewing gum is cooled before being cut. Molten gum is hard to cut. The purpose of the specification is to describe the invention to persons skilled in the art. A detailed explanation of conventional processing techniques, old in the art, is not necessary to achieve this end.

In summary, the invention as claimed is fully supported by the specification.

Respectfully submitted,



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
03/044,240	04/07/93	MC HALE	1331-1275

JEFFERY M. DUNCAN
WILLIAM BRINKS OLDS HOFER GILSON & LIONE
P.O. BOX 10395
CHICAGO IL 60610

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EXAMINER

SHEPHERD, C

ART UNIT

1302

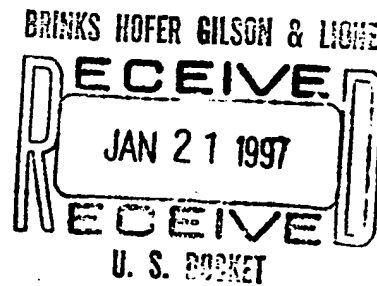
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DATE MAILED:

01/15/97

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Commissioner of Patents and Trademarks





UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
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Washington, D.C. 20231

The reply brief filed 12/16/96 has not been entered because it is not limited to new points of argument or to new grounds of rejection raised in the examiner's answer. See MPEP § 1208.03. Appellant has TWO MONTHS from the date of this communication to petition under 37 CFR 1.181 to request entry of the reply brief.

Specifically, the points raised in the reply brief revolve around whether the specification provides support for certain characteristics of the claim product. This issue was raised first in Appellants' brief, the Examiner responded to this issue in the Examiner's Answer, Appellants addressed this same issue in their Reply Brief, which the Examiner responded to in his Supplemental Examiner's Answer. The Appellants again raise the same issue in their Reply to the Supplemental Examiner's answer. The Examiner considers that Appellants have had ample opportunity to present their arguments on this point. Therefore, the Examiner is not entering Appellants' latest Reply.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Curtis Sherrer whose telephone number is (703) 308-3847. The examiner can normally be reached on Monday through Friday from 6:00 to 2:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Esther Kepplinger, can be reached on (703)-308-2339. The fax phone number for this Group is (703)-305-3602.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0651.

Curtis E. Sherrer

January 8, 1997

ESTHER KEPPLINGER
SUPERVISORY PATENT EXAMINER
GROUP 1300